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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/934,192 | 08/21/2001 | Shigeki Matsumoto | 450100-03419 | 7724 |
| 20999 7590 08/19/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER BURGESS, BARBARA N | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 09/934,192 | Applicant(s) MATSUMOTO, SHIGEKI | |
| | Examiner BARBARA N. BURGESS | Art Unit 2457 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-3-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Appeal Brief filed May 14, 2009. The Finality of claims 1-8 has been withdrawn. Prosecution is hereby reopened. Claims 1-8 are presented for further examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakita (hereinafter "Yam", European Patent Application 0 865 192 A2) in view of Shaffer et al. (hereinafter "Shaffer", US Patent 6,092,114) and in further view of Codignotto (US Patent Publication 2006/0143307 A1) and in further view of Zachery (US Patent 5,283,887).

As per claim 1, Yam discloses data communication system for sending and receiving e-mail between electronic devices by an e-mail system using a transmission control protocol/Internet protocol (TCP/IP) as a communication protocol, said data communication system comprising:

- A transmitting electronic device including at least an e-mail sending/receiving function for attaching obtained original data to the e-mail, adding a processing command and sending the e-mail to a network (column 1, lines 1-3, column 3, lines 4-7, column 5, lines 4-10);
- A relay server for receiving the e-mail sent from said transmitting electronic device, processing the original data attached to the e-mail based on the added processing command, attaching the processed data to the e-mail, and sending the e-mail to a receiving electronic device (column 3, lines 9-16, 28-31, column 5, lines 25-40, column 6, lines 1-7, 24-30).

Yam does not explicitly disclose:

- Wherein said processing command indicates an instruction for editing the attached obtained original data;
- Wherein the processing commands are described in text format and predetermined between the electronic devices.

However, in an analogous art, Shaffer discloses a client sending a request to a local server requesting manipulation of an attachment located in an email attachment. The request is for format conversion of the attachment. If the local server can not perform the conversion, a request is then sent to a remote server (column 4, lines 15-20, 65-67, column 5, lines 1-9, 22-30, column 7, lines 20-25, 39-62).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Shaffer's processing command indicates an instruction for editing the obtained original data and described in text format

and predetermined between the electronic devices in Yam's system in order to for the recipient user to have access of the attached file.

Yam, in view of Shaffer, does not explicitly disclose:

- Wherein said processing command is added to the obtained original data at the time of obtainment.

However, in an analogous art, Codignotto discloses a user sending an email to a system containing commands. The system checks the email for any commands that might have been added by the user. The commands are extracted and used during processing and publishing of the email (paragraphs [0180-0181]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Codignotto's processing command is added to the obtained original data at the time of obtainment in order that the system identifies the commands and is able to process them accordingly.

Yam, in view of Shaffer and Codignotto, does not explicitly disclose:

- Wherein a unique processing command for the transmitting electronic device is processed when the unique processing command is predetermined between the transmitting electronic device and the relay server.

However, in an analogous art, Zachery teaches sending documents from a first user to a recipient user, and for each user, means for creating and editing documents. A user preference table contains, for each user, an entry specifying the document format preferred by each user. A tag is appended specifying the user and enabling a format the user to be found in the user preference table. The user preference table include

preferences for the first user as well as the recipient user (Abstract, column 1, lines 58-61, column 3, lines 28-35).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Zachery's unique processing command in Yam's system in order to convert the document from the first format to the preferred format.

As per claim 2, Yam discloses a data communication system according to claim 1, wherein said electronic devices comprise an image pick-up device for capturing still image data as the obtained original data, and the processing command comprises an editing command for editing the still image data (column 1, lines 52-58, column 3, lines 26-30, column 5, lines 14-24).

As per claim 3, Yam discloses a data communication system according to claim 1, wherein the processing command is in a text format and is predetermined by an agreement between said transmitting electronic device and said relay server (column 5, lines 48-58).

As per claim 4, Yam discloses a data communication system according to claim 1, wherein said transmitting electronic device is connected to said network via communication means using Bluetooth standards (column 5, lines 25-35, column 13, lines 15-17, 28-30) .

As per claim 5, Yam discloses a data communication method for sending and receiving e-mail between electronic devices by an e-mail system using a TCP/IP as a communication protocol, said data communication method comprising the steps of:

- Attaching original data obtained in a transmitting electronic device to the e-mail adding a processing command and sending the e-mail from said transmitting electronic device to a network (column 1, lines 1-3, column 3, lines 4-7, column 5, lines 4-10);
- Receiving the email sent from said transmitting electronic device a relay server on said network, processing the original data attached to the e-mail based on the added processing command, attaching the processed data to the e-mail and sending the e-mail to a receiving electronic device (column 3, lines 9-16, 28-31, column 5, lines 25-40, column 6, lines 1-7, 24-30).

Yam does not explicitly disclose:

- Wherein said processing command indicates an instruction for editing the obtained original data.

However, in an analogous art, Shaffer discloses a client sending a request to a local server requesting manipulation of an attachment located in an email attachment. The request is for format conversion of the attachment (column 4, lines 15-20, 65-67, column 5, lines 1-9, 22-30, column 7, lines 39-62).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Shaffer's processing command

indicates an instruction for editing the obtained original data in Yam's system in order to for the recipient user to have access of the attached file.

Yam, in view of Shaffer, does not explicitly disclose:

- Wherein said processing command is added to the obtained original data at the time of obtainment.

However, in an analogous art, Codignotto discloses a user sending an email to a system containing commands. The system checks the email for any commands that might have been added by the user. The commands are extracted and used during processing and publishing of the email (paragraphs [0180-0181]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Codignotto's processing command is added to the obtained original data at the time of obtainment in order that the system identifies the commands and is able to process them accordingly.

Yam, in view of Shaffer and Codignotto, does not explicitly disclose:

- Wherein a unique processing command for the transmitting electronic device is processed when the unique processing command is predetermined between the transmitting electronic device and the relay server.

However, in an analogous art, Zachery teaches sending documents from a first user to a recipient user, and for each user, means for creating and editing documents. A user preference table contains, for each user, an entry specifying the document format preferred by each user. A tag is appended specifying the user and enabling a format the user to be found in the user preference table. The user preference table include

preferences for the first user as well as the recipient user (Abstract, column 1, lines 58-61, column 3, lines 28-35).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Zachery's unique processing command in Yam's system in order to convert the document from the first format to the preferred format.

As per claim 6, Yam further discloses a data communication method according to claim 5, wherein said transmitting electronic device comprises an image pick-up device for capturing still image data as the obtained original data, and the processing command comprises an editing command for editing the still image data (column 1, lines 52-58, column 3, lines 26-30, column 5, lines 14-24).

As per claim 7, Yam discloses a data communication method according to claim 5, wherein the processing command is in a text format and is predetermined by an agreement between said transmitting electronic device and said relay server (column 5, lines 48-58).

As per claim 8, Yam discloses a data communication method according to claim 5, wherein said transmitting electronic device is connected to said network via communication means using Bluetooth standards (column 5, lines 25-35, column 13, lines 15-17, 28-30).

Response to Arguments

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

The Office notes the following argument(s):

(a) Yamakita, Shaffer, Codignotto, and Capiel fail to teach or suggest handling of unique processing commands.

(b) Yamakita, Shaffer, Codignotto, and Capiel fail to teach or suggest “a unique processing command for the transmitting electronic device is processed when the unique processing command is predetermined between the transmitting electronic device and the relay server.”

In response to:

(a)-(b) Zachery is now cited for teaching such feature (see rejection of claims 1 and 5). Furthermore, Codignotto teaches the user's preferences or the reviewers' preferences may be used to determine how the email and any attachments are to be published. The command(s) extracted specify simple commands as well as complex instructions (paragraphs [0185-0189]).

Therefore, the combination of Yamakita, Shaffer, Codignotto, and now Zachery indeed discloses “a unique processing command for the transmitting electronic device is processed when the unique processing command is predetermined between the transmitting electronic device and the relay server.”

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA N. BURGESS whose telephone number is (571)272-3996. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Barbara N Burgess/
Examiner, Art Unit 2457

Barbara N Burgess
Examiner
Art Unit 2457

August 13, 2009

/ARIO ETIENNE/
Supervisory Patent Examiner, Art Unit 2457